

135946-1

REMARKS

Claims 1-3, 7-65, 68-69, 71-74, and 77-112 are pending in the present Application. Claims 108-112 have been allowed; claims 17, 25 and 65 have been canceled; and claims 1, 13, 44, 63, 78, 87-88, and 107 have been amended, leaving claims 1-3, 7-16, 18-24, 26-64, 68-69, 71-74, and 77-112 for consideration upon entry of the present Amendment. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Objections

The structure of claims 1, 63, 78, and 107 have been objected to as the purification steps were provided after a reaction and/or a combining step. The claims have been amended to clearly state which component is purified prior to a reaction or combining step. Claim 25 is objected to as failing to further limit the subject matter of the preceding claim. Claim 25 has been canceled. Accordingly, removal of the claim objections is respectfully requested.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-3, 7-65, 68-69, 71-74, and 77-107 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking proper scope of enablement as one of ordinary skill in the art would not be able to practice the invention without undue experimentation. The Applicants respectfully disagree.

The application is directed to obtaining polymeric material having reduced levels of particulate impurities. Several methods of obtaining such polymeric material are taught in the application, including how to obtain material substantially free of visible particulate impurities as well as materials substantially free of particulate impurities greater than about 15 micrometers (see paragraph [0019] of the specification as filed). Furthermore, methods are provided to maintain the polymeric material free of particulate impurities (e.g., transporting and storing the polymeric material in an environment substantially free of particulate impurities).

135946-1

The independent claims 1, 63, 78, and 107 are directed to methods of obtaining a polymeric material substantially free of visible particulate impurities. According to the claims, such a limitation is the highest limit of impurity allowed in the polymeric material. However, lower limits of impurity are also possible. The particular process provided in the independent claims can provide a polymeric material with reduced amounts of impurities smaller in size than visible particulates and in smaller quantities. Accordingly, independent claims 1, 63, 78, and 107 provide the minimum processing parameters known to ensure a polymeric material substantially free of visible particulate impurities. The additional optional purifying steps provided in independent claims 1, 63, 78, and 107, or the additional purifying steps found in the dependent claims, provide a polymeric material having an impurity level which is the same or substantially less than the amount allowed in the independent claims. Accordingly, one of ordinary skill in the art would not be burdened with undue experimentation in order to obtain a material substantially free of visible particulate impurities.

The Applicants wish to expand on the Examiner's discussion of Example 1 and Comparative Example 1 in the Office Action of April 5, 2005. Example 1 describes a process to provide a polymeric material having low levels of impurities. Among other processing parameters, Example 1 includes gravity filtering a polyphenylene ether and polystyrene solution through a 5-micrometer size filter bag, followed by concentrating and filtering the concentrate through a parallel combination of two sintered metal filters. (Specification paragraphs [0183-0185]) Comparative Example 1 only employs the gravity filtration step. (Specification paragraph [0192])

Table 2 provides the results of analyzing the particulate impurities of each material obtained according to Example 1 and Comparative Example 1. The material of each example shows roughly similar amounts of particulate impurities for impurities visible to the eye (e.g. typically greater than 40 micrometers in diameter, see paragraph [0018]). The significant difference in the impurity amounts between the two examples is illustrated by the amounts of the impurities having sizes smaller than what is visible to the naked eye. See for example particles sizes of 5 or 10 micrometers of Table 2. The use of the gravity filtration does provide a material

135946-1

with low amounts of visible particulate impurities, yet it is the use of additional filters that provides a polymeric material having even lower amounts of impurity. Accordingly, the Applicants believe the claims and specification fully inform one of ordinary skill in the art which processing parameters are needed to obtain a material substantially free of visible particulate impurities. As such, no undue experimentation would be required. Reconsideration and removal of the § 112 rejections is respectfully requested in view of the foregoing remarks.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 63-64, 68-69, and 71-74 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over JP 63-256426 to Moritani et al. ("Moritani").

Moritani generally discloses a method of producing optical elements prepared by fused molding of a resin composition obtained by first dissolving a resin composition consisting of a polymeric portion mainly containing aromatic vinyl monomer and polyphenylene ether portion, followed by removing the foreign particles by filtration of the solution obtained by dissolving the composition in an organic solvent and then removing the organic solvent by passing it through an extrusion type pelletization machine having a vent in it.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

As amended, claim 63 requires the combining, the obtaining, the purifying, or a combination of the foregoing steps be performed under an inert atmosphere. Moritani does not teach or suggest such a limitation, and therefore fails to teach each and every element of claim 63. Accordingly, Moritani fails to render claim 63 or its dependent claims obvious. The Applicants, therefore, respectfully request reconsideration and allowance of the claims.

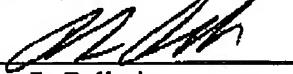
135946-1

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

CANTOR COLBURN LLP

By 

Roberta L. Pelletier
Registration No. 46,372

Date: June 3, 2005
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No.: 23413